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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,612	10/24/2000	Joseph B. Richey II	INVA-Q-CIP-2	2971

24024 7590 02/06/2004

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EXAMINER

WEISS JR, JOSEPH FRANCIS

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/06/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,612

Applicant(s)

RICHEY ET AL.

Examiner

Joseph F Weiss Jr.

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 20-24 and 28-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION
Election/Restrictions

1. This application contains claims 11-19 & 25-27 are drawn to an invention nonelected without traverse in Paper No.6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino et al. (5144945) in view of Rossen (5823186).

Nishino teaches a portable oxygen enrichment apparatus with a two sets of high pressure storage containers (59 & 60 and 61) for portable storage of high pressure oxygen enriched gas, a concentrated oxygen source, wherein said oxygen enriched gas contains at least 50% oxygen (Col. 9, l. 12) an a compressor (47) and where fluidically the compressor is located both before both sets of high pressure storage tanks and also inbetween the first set 59/60 and the second 61 by dint of the fact that between the compressor and the first set there is bi-directional flow (best seen along the compressor tanks 59/60 flow lines at the base of the device) , but it does not teach the use of the old and well known compressor species known as a "radial compressor". However, Rossen

discloses that a teaching of "compressor" includes the use of radial compressors in the respiratory arts (See brief summary & claim 3).

The references are analogous since they are from the same field of endeavor, the respiratory arts. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to use a "radial compressor" with the device of Nishino because such a species of compressor is known to be within the scope of a teaching of a compressor in the respiratory arts. Therefore it would have been obvious to combine the references to obtain the instant application's claimed invention. Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather than constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

2. Claims 2-4, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino & Rossen as applied to claim 1 above, and further in view of Beysel (US 4428372).

In regards to claims 2-4, the suggested device substantially discloses the instant application's claimed invention, but does not explicitly disclose prioritization of feeding gas to the compressor verses the user based upon oxygen sensing. However, Beysel et al teaches an oxygen enrichment apparatus which as a prioritized and switchable oxygen stream between a user (8) or a storage vessel (40) determined by the minimum required oxygen level for a user by an oxygen sensor (60 & Col. 4, l. 5). The references are analogous since they are from the same field of endeavor, the respiratory arts. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to have taken the features of Beysel and used them with the suggested device. The suggestion/motivation for doing so would have been to

Art Unit: 3743

insure a user is properly oxygenated. Therefore it would have been obvious to combine the references to obtain the instant application's claimed invention. Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather than constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

In regards to claim 7-8, the suggested device is fully capable of enriching oxygen content by volume in the range of 85%.

3. Claims 5-6, 9-10, 20-24, 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino, Rossen & Beysel as applied to claims 3 & 4 above, and further in view of Odagiri (US 5195874).

In regards to claims 5 & 6, the suggested device substantially discloses the instant application's claimed invention, but does not explicitly disclose use of sequentially smaller pistons for multi-stage gas compression. However, Odagiri teaches a multistage gas compressor with a plurality of cylinders (23 & 24) which sequentially compress a gas (Col. 4, ls. 23-33) and where the sequential pistons have a smaller diameter (Note the different diameters of cylinders 29 & 30) which reciprocate within their respective cylinders with a crankcase (22) which would inherently contain the crankshaft to which the pistons would be attached by piston rods. While Odagiri does not show the pistons of its compressor it does illustrate pistons with both head and base portions and rods of the prior art and it does not teach away from the prior art on these elements. Nishino teaches the use of a compressor, of which Odagiri is an example, therefore one of ordinary skill in the art would at the time of the instant application's invention was made would consider it obvious to use the compressor of Odagiri with the disclosed device of the applied art to provide for the storage of enriched

oxygen at a increased pressure. The references are analogous since they are from the same problem solving area, gas compression. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to have taken the features of Odagiri and used them with the suggested device. The suggestion/motivation for doing so would have been to optimize gas compression. Therefore it would have been obvious to combine the references to obtain the instant application's claimed invention. Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather than constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

In regards to claim 9-10, the suggested device is fully capable of enriching oxygen content by volume in the range of 90%.

In regards to claim 28, the references noted above substantially disclose the claimed invention except for the placement of pistons in a non-adjacent circumferential position about a crankshaft. It is noted that applicant's specification does not set forth this placement, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art. Accordingly, the examiner considers the selection of such to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claim 29, the references noted above substantially disclose the claimed invention except for the use of five piston/cylinder/rod sets. It is noted that applicant's specification does not set forth this number of piston/cylinder/rod sets, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art. Accordingly, the examiner considers the selection of such to be a

Art Unit: 3743

mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claim 30, the reference noted above substantially disclose the claimed invention except for the single throw functionality of the crankshaft/piston/rod assembly. It is noted that applicant's specification does not set forth this single through functionality, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art. Accordingly, the examiner considers the selection of such to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claim 31, the suggested device is fully capable of achieving a gas pressure in the range of 1500-3000 psi.

In regards to claim 32, the rejections to claims 28-30 are herein incorporated by reference against the limitations of claim 32.

In regards to claim 33, the reference noted above substantially disclose the claimed invention except for the array of pistons based upon non-sequential arraying of the pistons for compression purposes. It is noted that applicant's specification does not set forth this non-sequential adjacent arraying of the pistons, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art. Accordingly, the examiner considers the selection of such to be a mere obvious matter of design choice and as such does not patently distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary.

In regards to claim 34, the suggested device is fully capable of achieving a gas pressure in the range of 1500-3000 psi.

In regards to method claims 20-24 & 35-37, one of ordinary skill in the art would appreciate that the method steps claimed in the instant application would naturally flow from the device disclosed in the prior art as noted above and therefore are rejected herein above with respect to claims 1-10 & 28-34.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10, 20-24 & 28-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5988165 in view of Rossen (US 5823186). Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a

portable oxygen enrichment apparatus with a high pressure storage container for portable storage of high pressure oxygen enriched gas, a concentrated oxygen source, wherein said oxygen enriched gas contains at least 50% oxygen and a compressor, but it does not teach the use of the old and well known compressor species known as a "radial compressor". However, Rossen discloses that a teaching of "compressor" includes the use of radial compressors in the respiratory arts (See brief summary & claim 3).

The references are analogous since they are from the same field of endeavor, the respiratory arts. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to use a "radial compressor" with the device because such a species of compressor is known to be within the scope of a teaching of a compressor in the respiratory arts. Therefore it would have been obvious to combine the references to obtain the instant application's claimed invention. Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather than constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

Response to Arguments

2. Applicant's arguments filed 7 Nov 03 have been fully considered but they are not persuasive, furthermore applicant's arguments with respect to claims 1-10, 20-24 & 28-38 have been considered but are moot in view of the new ground(s) of rejection in terms of re-evaluation of the facts and evidence of the reference the previously presented/used in the rejection.

Art Unit: 3743

3. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's contention that his rearrangement of the ordering/sequence of taking oxygen enriched air and feeding it into the compressor and then putting it into another high pressure container, such a mere reversal/rearrangement of known parts for a known purpose does not constitute an patently distinct difference under 35 USC 103, but instead such is considered a mere obvious reversal/rearrangement. Nishino has 2 sets of high pressure containers, those with the sorbtion beds and tank 61, both of which have oxygen enriched air, in conjunction with a compressor, merely placing the compressor in between these two sets of high pressure enriched oxygen cylinders instead of in front of them is a mere

Art Unit: 3743

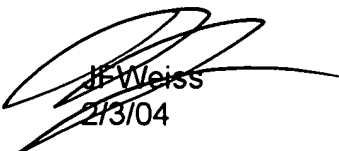
reversal/rearrangement of parts. *In re Einstein*, 8 USPQ 167 Furthermore, fluidically by dint of the fact that high-pressure tanks 59/60 have bi-direction flow, the sequential limitations set forth by applicant are met. Since oxygen in tank 61 is 40-60% this concentration must first be achieved in tanks 59/60 thus the limitations as set forth by applicant are met.

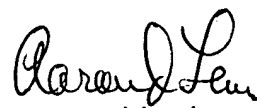
Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F Weiss Jr. whose telephone number is 703-305-0323. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JF Weiss
2/3/04


Aaron J. Lewis
Primary Examiner